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| 09/574,985 | 05/19/2000 | Dana W. Wolcott | 80724PF-P | 9582 |

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PATENT LEGAL STAFF
EASTMAN KODAK COMPANY
343 STATE STREET
ROCHESTER, NY 14650-2201

EXAMINER

BROWN, TIMOTHY M

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1648

DATE MAILED: 10/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/574,985

Applicant(s)

WOLCOTT ET AL.

Examiner

Tim Brown

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

In view of the Appeal Brief filed on June 14, 2004, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

All rejections set forth in the Final Office Action mailed December 30, 2003 are withdrawn.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental

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premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts." See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts."

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature," "natural phenomena," and "abstract ideas." See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

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The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an

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abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, *State Street* never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

In the instant case, Applicant's method of delivering a photographic product does not actively involve technology in any non-trivial way. Accordingly, claims 1-23 are rejected as being drawn to non-statutory subject matter.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 15-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This is because the selecting step in each of independent claims 15 and 18 does not clarify whether 1) both a camera and a photographic product/service are selected, or 2) the camera is selected from a menu comprising a plurality of cameras, photographic products and photographic services. This rejection may be overcome by amending the claim to recite separate selecting steps, or by clearly stating the claimed selecting is from the menu just described.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 8, 11, 13-15, 24 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over “Ricoh” (“Ricoh to Bundle Club Photo Internet-based Photo Sharing Software with New 2-Megapixel Digital Camera” Business Wire (June 8, 1999)) in view of Cameraworld.¹

Applicant's invention is a method and system for providing photographic products and/or services comprising choosing a camera from a selection of cameras, selecting a service plan or product from a menu, associating the selected camera with the selected plan or product to create an account, and entering the account into a database to maintain a record of products or services to be provided in accordance with the selected plan.

Ricoh is evidence that Applicant's method and system were publicly known, and in use, before the date of invention. Ricoh expressly discloses selecting a camera (p. 1, lines 18-20), associating the selected camera with a service plan to create an online account (p. 1, lines 5-6; and p. 2, lines 2-4), and entering account information into a database to maintain a record of products or services to be provided (p. 1, line 8).

Note that the attached “Club Photo” Web pages serve as extrinsic evidence that Ricoh relied on the claimed selecting “from a menu of photographic product and/or photographic service plans” (e.g. claim 1). Ricoh states that the service that is packaged with its camera is provided through a “Club Photo” membership. The attached Club

¹ <http://web.archive.org/web/19970414000034/http://www.cameraworld.com/index.html>

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Photo Web pages show that the service mentioned in Ricoh required members to choose between a standard and upgraded membership. Thus, Applicants' selecting "from a menu of photographic product and/or photographic service plans" was known and in public use as part of Ricoh's method.

Ricoh and Club Photo do not establish that selecting a camera from "among a selection of cameras" (e.g. claim 1) was publicly known and/or used. However, Cameraworld shows that at the time of Applicant's invention, the Internet was being used to offer consumers an online camera catalog (i.e. a selection of cameras). Therefore, at the time of Applicant's invention, it would have been obvious to one of ordinary skill in the art, to modify Ricoh to include Cameraworld's online selection of cameras. This combination would allow Ricoh's to market its camera over the Internet.

Note that the Club Photo Web page with the heading "FREE Membership for Everyone" serves as extrinsic evidence that the following were publicly known and/or used:

storing a digital record for a predetermined period of time (*n.b.*: Club Photo recycles Web pages after a predetermined period of time); and

providing an image product (*n.b.*: Club Photo sells "photo finishing products personalized with your favorite photots").

Ricoh discloses updating the product/service plan account as claimed. This is because as users upload pictures to the Club Photo server, their personalized Web pages (i.e. Web accounts) are updated to reflect the change.

Claims 2, 3, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frink (Frink, S. "Ocean Divers; a full service dive resort on the

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**shores of Pennekamp Park” Skin Diver (August, 1985) Vol. 34, p. 102) in view of
“Promo” (Creative Gallery: ‘Olympus Camera Craze’” Promo (September 1994)).**

Frink teaches a method of providing photographic products and/or service,
comprising:

selecting a camera among a selection of cameras (p. 1, lines 8, 16 and 19);

selecting a photographic service plan from a menu of plans (p. 1, lines 8-9, 17-
22;

associating the selected camera with the selected photographic product to create
an account (p. 1, lines 8-9, 17-22);

wherein the selected camera is provided for a predetermined period of time for a
predetermined fee (p. 1, lines 16).

Frink does not expressly teach entering a user's account information into a
database. However, one skilled in the art of renting camera equipment would recognize
that greater organization and information access could be gained by electronically
storing transaction information. Therefore, at the time of Applicant's invention, it would
have been obvious to one of ordinary skill in the art, to modify Frink to include entering
the user's transaction information into a database.

Note that Frink does not expressly teach providing film development for a
predetermined number of rolls of film. However, Promo teaches promoting the sale of a
camera by offering free film developing for a predetermined number of rolls of film. At
the time of Applicant's invention, it would have been obvious to one of ordinary skill in
the art, to modify Frink to include providing film development for a predetermined
number of rolls of film as this combination would encourage consumers to rent Frink's
cameras.

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Claims 4-8, 17 and 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frink in view of Promo and "Film Processors" ("Film Processors Deliver Snapshots Electronically To Your Computer" Orange County Register (March 4, 1997)).

Frink and Promo teach all the limitations noted above. Frink and Promo do not expressly teach scanning film to create a digital record, placing the digital record on a disk, and/or forwarding the images to a recipient. However, Film Processors discloses scanning images to create a disk of images, transmitting images to designated recipients, and storing the images for a predetermined period of time (p. 1, lines 3-5, 9 and 13-14). At the time of Applicant's invention, it would have been obvious to one of ordinary skill in the art, to modify Frink and Promo to include Film Processors' scanning film to create a digital record, placing the digital record on a disk, and/or forwarding the images to a recipient. This combination would enable the skilled artisan to offer a wider range of photographic services thereby increasing demand.

Note that even if Frink, Promo and Film Processors did not teach "storing said digital record for a *predetermined period of time*," it would have been obvious to include this feature. This results for at least two reasons. First, the skilled artisan would recognize that perpetually maintaining a Web page for every customer would result in the wasting of storage space on delinquent accounts. Second, storing a digital record for a predetermined period of time would enable the skilled artisan to offer an online subscription service for a fee. Thus, one of ordinary skill would have been motivated to make the stated combination.

Claim 9, 10, 12, 16, 25-27 and 33-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ricoh in view of Cameraworld and "PhotoAccess.com"

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(“New sites offer prints from digital cameras” Photo Marketing Newslane (December 15, 1999)).

With respect to claim 9, Ricoh and Cameraworld teach all the limitations discussed above. Ricoh and Cameraworld do not expressly teach providing a predetermined number of prints of images from the selected camera. However, PhotoAccess.com discloses a promotion wherein digital camera users are provided with 5 free prints. At the time of Applicant's invention, it would have been obvious to one of ordinary skill, to modify Ricoh and Cameraworld to include providing a predetermined number of prints as taught by PhotoAccess.com in order to promote camera sales.

Regarding claims 10, 12 and 25, Ricoh and Cameraworld do not expressly teach wherein the selected camera is a film camera. However, PhotoAccess.com teaches providing an online film service wherein consumers use a scanner to printed images to an online service, wherein the online service uses the images to create an online photoalbum, or provide additional prints. At the time of Applicant's invention, it would have been obvious to one of ordinary skill in the art, to modify Ricoh and Cameraworld to include the teachings of PhotoAccess.com. Such a combination would provide a wider range of image service options thereby improving customer satisfaction and establishing goodwill.

Claims 28-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ricoh in view of Cameraworld, PhotoAccess.com and Film Processors (“Film Processors Deliver Snapshots Electronically To Your Computer” Orange County Register (March 4, 1997)).

Ricoh, Cameraworld and PhotoAccess.com Promo teach all the limitations noted above. Frink and Promo do not expressly teach scanning film to create a digital record, placing the digital record on a disk, and/or forwarding the images to a recipient.

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However, Film Processors discloses scanning images to create a disk of images, transmitting images to designated recipients, and storing the images for a predetermined period of time (p. 1, lines 3-5, 9 and 13-14). At the time of Applicant's invention, it would have been obvious to one of ordinary skill in the art, to modify Frink and Promo to include Film Processors' scanning film to create a digital record, placing the digital record on a disk, and/or forwarding the images to a recipient. This combination would enable the skilled artisan to offer a wider range of photographic services thereby increasing demand

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: "Camera buyers get free World Wide Web posting" Nikkei Weekly, (February 14, 2000) Vol. 38 p. 12.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tim Brown whose telephone number is (571) 272-0773. The examiner can normally be reached on Monday - Friday, 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel can be reached on (571) 272-0902. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.


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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tim Brown
Examiner
Art Unit 1648

tb



Jeffrey A. Smith
Primary Examiner